



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/503,939	02/14/2000	Andrew H. Gafken	2207/8478	7313
23838	7590	05/18/2005	EXAMINER	
KENYON & KENYON 1500 K STREET, N.W., SUITE 700 WASHINGTON, DC 20005			SONG, HOSUK	
			ART UNIT	PAPER NUMBER
			2135	

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	GAFKEN ET AL.	
09/503,939		
Examiner Hosuk Song	Art Unit 2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 28 February 2005.
2a) This action is FINAL. 2b) This action is non-final.
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 7-10,16-26 and 28-36 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) Claim(s) _____ is/are allowed.
6) Claim(s) 7-10,16,17,20,22,24 and 26,28-36 is/are rejected.
7) Claim(s) 18,19,21,23 and 25 is/are objected to.
8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____.

DETAILED ACTION

1. Please note that the application has been docketed to a different examiner. Please refer all future communications regarding this application to the examiner of record, using the information supplied in the final section of the office action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 7 is rejected under 35 U.S.C. 102(e) as being anticipated by Anderson(US 6,003,130).

Claim 7: Anderson disclose upon restart of the processor,determining whether memory contains a BIOS package in (fig.3). Anderson discloses authenticating the BIOS package in (col.2,lines 51-55). Anderson disclose upon successful authentication storing the BIOS package in a reprogrammable BIOS memory space in (fig.2 and col.3,lines 36-41).

3. Claims 16-17,20,22,24 are rejected under 35 U.S.C. 102(e) as being anticipated by Rakavy et al.(US 5,978).

Claims 16,17: Rakavy disclose executing a system BIOS from a default memory space,executing an ancillary BIOS according to determining whether an ancillary BIOS exists in an alterable memory space, if no ancillary BIOS exists in the alterable memory space,executing an ancillary BIOS from the default memory space in (col.21,lines 5-16).

Claim 20: Rakavy disclose determining whether an ancillary BIOS package is present in an enhancement space of firmware, if the ancillary BIOS package is present, determining whether a predetermined user command has been entered, if the predetermined user command has not been entered ,executing the ancillary BIOS package from the enhancement space, otherwise, executing an ancillary BIOS from a default space of firmware in (col.9,lines 21-40 and fig.3a-3b).

Claim 22: Rakavy disclose determining whether an ancillary BIOS package is present in an enhancement space of firmware, the ancillary package BIOS package update, if the ancillary BIOS package is present,determining whether a predetermined flag has been set in the firmware, if the predetermined flag has been set,executing the ancillary BIOS package from the enhancement space,otherwise,executing an ancillary BIOS from a default space of firmware in (fig.3b,col.6,lines 54-65; col.9,lines 21-40 and fig.3a-3b).

Claim 24: Rakavy disclose determining whether an ancillary BIOS package is present in an enhancement space of firmware,the ancillary BIOS package including a BIOS update, if the ancillary BIOS package is present in the enhancement space(fig.3b,col.6,lines 54-65; col.9,lines 21-40 and fig.3a-3b),decompressing the ancillary BIOS package and executing the ancillary BIOS package in (col.7,lines 57-66).

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 9-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Follendore(US 5,369,707).

Claim 9: Follendore disclose a processor ,firmware electrically connected to the processor, the firmware comprises a first storage space to store a first system BIOS, the first storage space being a ROM, a second storage space to store a second system BIOS and an

Art Unit: 2135

index table, the associating elements of the second system BIOS with elements of the first system BIOS in (col.5,lines 26-41;col.17,lines 26-31 and fig.11).

Claim 10: Follendore disclose first storage space is to store a system BIOS and at least one ancillary BIOS and the index table identifying the BIOSs in (col.7,lines 44-54).

5. Claim 26,31-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Shipman et al.(US 5,671,413).

Claim 26: Shipman disclose during execution of a system BIOS,determining whether a video BIOS exists in an alterable firmware section of a memory system, if no video BIOS exist in the alterable section,executing a video BIOS in a nonalterable firmware section in the memory system in (fig.1 and col.3,lines 32-44).

Claim 31: Shipman disclose determining whether a video BIOS package is present in an enhancement space of firmware, if the video BIOS package is present,determining whether a predetermined user command has been entered,if the predetermined user command has not been entered,executing the video BIOS package from the enhancement space,otherwise,executing a video BIOS from a default space of firmware in (fig.1 and col.33-44;col.7,lines 1-10).

Claim 32: Shipman disclose decompressing a video BIOS from the enhancement space and executing the decompressed video BIOS in (col.3,lines 13-21).

Claim 33: Shipman disclose during execution of a system BIOS, determining whether a video BIOS package is present in an enhancement space of firmware, the video BIOS package in the enhancement space including a BIOS update in (fig.1). Shipman disclose if the video BIOS package is present,determining whether a predetermined flag has been set in the firmware, if the predetermined flag has been set,executing the video BIOS package from the

enhancement space, otherwise executing a video BIOS from a default space of firmware in (col.3,lines 13-44).

Claim 34: Shipman disclose decompressing a video BIOS from the enhancement space and executing the decompressed video BIOS in (col.1,lines 51-56).

Claims 35,36: Shipman disclose during execution of a system BIOS, determining whether a video BIOS package is present in an enhancement space of firmware, the video BIOS package in the enhancement space including a BIOS update in (fig.1). Shipman disclose if the video BIOS package is present in the enhancement space,decompressing the video BIOS package and executing the video BIOS package in (col.1,lines 51-56).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson(US 6,003,130).

Claim 8: Anderson does not specifically disclose determining whether the BIOS package is successfully stored in the reprogrammable BIOS memory space, if so, report a success flag identifying the BIOS package as successfully stored. It would have been obvious to person of ordinary skill in the art to modify the invention of Anderson to include a success flag identifying the BIOS package as successfully stored in order to alert the user system is operating according to the procedure without any errors.

7. Claim 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shipman et al.(US 5,671,413) in view of Rossi(US 5,564,020).

Claims 28-30: Shipman does not specifically disclose if a video BIOS exists in the alterable section, executing the video BIOS in the alterable section. Rossi disclose executing the video BIOS in alterable section in (col.4,lines 43-51). It would have been obvious to person of ordinary skill in the art at the time invention was made to execute the video BIOS in the alterable section as taught in Rossi with video BIOS disclosed in Shipman in order to adapt, configure and customize different types of video BIOS in order to enhance the system's capability.

Allowable Subject Matter

8. Claims 18,19,21,23,25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Appeal Brief

9. Claims 7-10,16-26,28-36 are pending. The previous grounds of rejection are withdrawn in view of Applicant's Appeal Brief filed on 2/28/2005. However, newly discovered prior art has necessitated new grounds of rejection. The new grounds of rejection are presented above. The delay in citation of the newly discovered prior art is regretted.

USPTO Contact Information

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hosuk Song whose telephone number is 571-272-3857. The examiner can normally be reached on Tue-Fri.

Art Unit: 2135

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HS

A handwritten signature consisting of the letters "HS" followed by a stylized, flowing cursive line.